

# Notice of Allowability

## Application No.

10/019,976

## Examiner

Golam M M Shameem

## Applicant(s)

BIGHAM ET AL.

## Art Unit

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### -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/27/2004.
2. ☒ The allowed claim(s) is/are 1-13, 19, 20 and 24-29 (now 1-21).
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

- |  |  |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                      |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date <u>10/23/01</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                              |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                               | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance             |
|  | 9. <input type="checkbox"/> Other _____  |

## **DETAILED ACTION**

### ***Priority***

This application is a 371 of PCT/EP00/03848 04/28/2000 and the claim of foreign priority under 35 U.S.C. § 119(a)-(d) to United Kingdom 9910110.7 04/30/1999 is acknowledged.

### ***Status of Claims***

Claims 1-17, 19, 20, and 24-29 are currently pending in the application. Claims 18, and 21-23 were previously canceled.

Receipt is acknowledged of Applicant's response filed on October 27, 2004 and that has been entered.

Claims 14-17 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

### ***Information Disclosure Statement***

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 10/23/2001, which has been entered in the file.

### ***Response to Election/Restriction***

In response to the restriction requirement, Applicants have elected Group I, which includes claims 1-13, 19, and 20 drawn to compounds with traverse is acknowledged. The traversal is on the ground(s) that the claims of Group II and III should be rejoined and examined with the elected Group I because "the Examiner has not cited any uses for the product other than the claimed uses" (Remarks, page 2).

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Applicant's arguments are fully considered and found partially persuasive and therefore, Examiner agrees to withdraw restriction requirements between Groups I and III and rejoin claims 24-29 (because those claims fall within the scope of elected invention), with the elected invention (Group I). However, during a telephonic interview, with Mr. Robert Brink (Attorney for Applicant) on November 22, 2004, Applicant has agreed to cancel non-elected claims 14-17 of Group II. Therefore, the Office action for restriction requirements (mailed on 10/01/2004) between the compounds and method of use claims has been withdrawn and hence, all remaining claims 1-13, 19, 20, and 24-29 have been allowed.

***Examiner's amendment***

An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this Examiner's amendment was given in a telephone interview with Mr. Robert Brink (Attorney for Applicant) on November 22, 2004.

The application has been amended as follows:

- a. Claims 14-17 have been canceled.

***Reasons for allowance***

The following is an Examiner's statement of reasons for allowance:

Huff *et al* (US 4,506,074) teach the substituted imidazole derivatives, and their methods of uses thereof. The instant compound differs from the prior art by having a core imidazole ring, which is further substituted by different variables such as R<sup>1</sup>-R<sup>6</sup> that are attached indirectly to the

core 5-membered heterocyclic ring. The prior art compounds neither teach nor render obvious the instantly claimed compounds or their method of preparation and there is no suggestion or motivation to modify the compounds of other prior art to obtain the instant compounds. Therefore the instant claims 1-13, 19, 20, and 24-29 are allowable over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy

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published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG  
89.

Any inquiry of a general nature or relating to the status of this application should be  
directed to the Group receptionist, whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read "Golam M M Shameem". The signature is stylized with a large, looping initial "G" and "M".

Golam M M Shameem, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1

November 23, 2004